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EXAMINER

JOHNSON, CARLTON

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/784,708
Filing Date: February 23, 2004
Appellant(s): RICE ET AL.

Christopher P. O'Hagan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6-3-2008 appealing from the Office action mailed 11-26-2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Art Unit: 2136

Claims 1, 2, 4-11, 13-18, and 21-24 are rejected under 35 U.S.C, § 103(a) as being unpatentable over Nassiri (U S Pub. No. 2002/0143711) in view of Broderick ("Electronic Signatures").

Applicant has neglected to indicate in the grounds of rejection the second prior art reference, "Electron Signatures" by Broderick.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

4. Claims **1, 2, 4 - 11, 13 - 18, 21 - 24** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Nassiri et al.** (US Patent No. **20020143711**) in view of "Electronic Signatures").

With Regards to Claims 1, 11, 18, Nassiri discloses a method, system, computer program product in a computer readable medium for verifying a document via a distributed computer network, the method comprising the steps of:

- (b) storing the electronic document on a server in the computer network; (see Nassiri paragraph [0081], lines 2-27; paragraph [0080], lines 1-5: upload, download, store electronic document on host system (i.e. server))
- (c) retrieving the electronic document using a notary application via a second client in the computer network; (see Nassiri paragraph [0080], lines 1-5: download (i.e. retrieve) electronic document)
- (f) electronically affixing a verifying party's signature and seal to the electronic document using said notary application via the second client, wherein said seal is stored electronically by said notary application, and wherein the verifying party may be any certified party that has authority by law to verify and authenticate the signer of a document; (see Nassiri paragraph [0095], lines 1-6: attach notary digital signature, notary seal for notary public to electronic document; paragraph [0096], lines 4-10; paragraph [0097], lines 24-28: seal function embedded within the computer system, seal function cannot operate without notary application (distributed application)) and
- (g) storing the signed, notarized, electronic document on said server. (see Nassiri paragraph [0102], lines 5-9: upload signed, notarized electronic document to host system (i.e. server))

Nassiri discloses the concern for legal ramifications of electronic signatures. (see Nassiri paragraph [0020]: concern for legal requirements for transactions) Nassiri does not specifically disclose whereby the option for acceptance of "Consent to Electronic Records". However, "Electronic Signatures" discloses wherein the option for a consumer to accept "Consent to Electronic Records" and further comprising:

- (a) creating an electronic version of the document on a first client in the computer network, wherein said electronic document includes an acceptance option for a Consent to Electronic Records (CER); (see Nassiri paragraph [0072], lines 5-9: download (i.e. create) electronic document; paragraph [0045], lines 10-16: software, implementation means; paragraph [0045], lines 10-16: software, implementation means) and (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)
- (d) presenting a signing party with said acceptance option for said CER; (see Nassiri paragraph [0076], lines 5-10: request to accept paperless (electronic) transaction information) and (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)
- (e) electronically affixing at least one signing party's signature to the electronic document using said notary application via the second client only if said signing party accepts the CER; (see Nassiri paragraph [0076], lines 5-10: request to accept paperless (electronic) transaction information; paragraph [0095], lines 1-6: attach digital signature to electronic document) and (see Electronic Signatures

pages 22-23: procedures for option of acceptance for consent to electronic records)

It would have been obvious to one of ordinary skill in the art to modify Nassiri as taught by "Electronic Signatures" to enable the capability for the option whereby a consumer to accept "Consent to Electronic Records". One of ordinary skill in the art would have been motivated to employ the teachings of "Electronic Signatures" in order to enable the capability to satisfy the legal requirements for electronic transactions. (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

With Regards to Claim 2, Nassiri discloses the method according to claim 1, wherein the verifying party in step (e) is a notary. (see Nassiri paragraph [0044], lines 1-4; paragraph [0041], lines 8-11: notary public is verifier)

With Regards to Claims 4, 13, Nassiri discloses the method, system, computer program product according to claims 3, 12, 19, wherein the seal is stored electronically in the notary application on the second client. (see Nassiri paragraph [0046], lines 9-12: attached notary seal device for notary public; paragraph [0045], lines 10-16: software, implementation means; paragraph [0096], lines 4-10; paragraph [0097], lines 24-28: seal function embedded within the computer system, seal function cannot operate without notary application (distributed application))

With Regards to Claims 5, 14, 21, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, wherein the verifying party's signature is stored on the second client. (see Nassiri paragraph [0046], lines 7-9: attached signature device for notary public; paragraph [0045], lines 10-16: software, implementation means)

With Regards to Claims 6, 17, 22, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, wherein the signing party is provided with the location of an authorized verifying party nearest to the signing party's geographic location. (see Nassiri paragraph [0082], lines 5-11: nearest location for notary public (i.e. verifying party); paragraph [0045], lines 10-16: software, implementation means)

With Regards to Claims 7, 15, 23, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, further comprising: creating and updating an electronic journal file containing information regarding the verification transaction, wherein said file is stored in a journal database for the verifying party. (see Nassiri paragraph [0047], lines 1-5; paragraph [0047], lines 8-14; paragraph [0101], lines 3-7: journal file for notarization; paragraph [0045], lines 10-16: software, implementation means)

With Regards to Claims 8, 16, 24, Nassiri discloses the method, system, computer

program product according to claims 7, 15, 23, wherein the information stored in the journal file may include: sending party; time; dates; type of document; fees; type of notarization; signer's signature; and verification information. (see Nassiri paragraph [0101], lines 3-7; paragraph [0043], lines 6-15: journal contains notary information required by law; paragraph [0045], lines 10-16: software, implementation means)

With Regards to Claim 9, Nassiri discloses the method according to claim 1, wherein an authorized verifying party can both create the electronic document and verify the electronic document. (see Nassiri paragraph [0044], lines 1-4; paragraph [0044], lines 7-11: notary; paragraph [0080], lines 1-5: download (i.e. create) electronic document; paragraph [0095], lines 1-6: verify electronic document)

With Regards to Claim 10, Nassiri discloses the method according to claim 1, wherein a certified creator can only create the electronic document. (see Nassiri paragraph [0080], lines 15-19: confidential documents for specific individual)

(10) Response to Argument

Claims 1, 2, 4-11, 13-18, and 21-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nassiri

Argument 1: Applicant argues that for Claim 1, 11, 18, Nassiri stores and applies the notary seal different from the approach used in the present invention. (see Pages 5-7 of Appeal Brief)

Applicant's invention discloses the notary seal and the software application are combined. The Nassiri prior art reference states that there is an embodiment of the prior art invention that has the notary seal device as a function embedded in the local computer system (software application). This fact is acknowledged by the Applicant on Appeal Brief Page 7, Lines 4-5. The preferred embodiment for the Nassiri prior art reference may be the situation where the notary input seal is a separate device from the software application. But, the Nassiri prior art reference clearly discloses that there are two implementations such as a separate notary seal device and an embedded notary seal device. Clearly, the Nassiri prior art referenced contemplated and disclosed an embedded notary seal device where the notarization application software and the notary seal device are combined as per claim limitation.

Applicant states that "all functions of storing and applying the seal are bundled together in the same software package that is used to execute the other notarization functions". The Nassiri prior art discloses the same embedded or bundled configuration for storing and applying the notary seal and execution of the other notarization functions using the embedded notary seal embodiment.

Applicant states that Nassiri teaches away from the electronic notary seal being part of the software application. The fact that Nassiri indicates an embodiment that

discloses the electronic notary seal being part of the software application indicates that Nassiri does not teach away from this implementation. The Nassiri prior art does not discredit or discourage the implementation of a combined notary seal device and software application since Nassiri indicates an embodiment with a combined notary seal device and software application.

Argument 2: Applicant argues that for Claim 1, 11, 18, Nassiri does not teach or suggest adding an acceptance option for Consent to Electronic Records (CER) to the electronic document and requiring a CER from a signer before allowing the document to be executed. (see Pages 8, 9 of Appeal Brief)

The Nassiri prior art reference discloses that its invention is concerned with legal ramifications in the processing of electronic documents. (see Nassiri paragraph [0020]: concern for legal requirements for transactions; paragraph [0072], lines 5-9: download (i.e. create) electronic document paragraph [0076], lines 5-10: request to accept paperless (electronic) transaction information) The Nassiri and Broderick prior art combination discloses an acceptance option for a user to consent to the usage of electronic records in managing electronic documents. The user is given an option to select consent to electronic records. (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

Argument 3: The accompanying dependents 2, 4 - 10, 13 - 17 21 - 24 are rejected due to rejected independent Claims 1, 11, 18.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

/Carlton V. Johnson/

Examiner, Art Unit 2136

Conferees:

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2135

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2136